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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,318	02/07/2002	David W. Stebbings	110267.201US3	8929

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EXAMINER

KIM, AHSHIK

ART UNIT PAPER NUMBER

2876

DATE MAILED: 05/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/067,318	Applicant(s) STEBBINGS ET AL.	
	Examiner Ahshik Kim	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/03/03 (Amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-22 and 25-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 42-46 is/are allowed.
- 6) ☒ Claim(s) 20,25-28,31-35 and 38-41 is/are rejected.
- 7) ☒ Claim(s) 21,22,29,30,36,37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continuation Data

1. Acknowledged this application is a divisional application of U.S. Serial No. 09/448,049,
5 filed on November 23, 1999, now US Patent 6,477,134, which is a continuation application of
PCT/US99/14261, filed on June 29, 1999, which claims priority from a provisional application
60/091,036, filed on June 29, 1998.

Amendment

- 10
2. Receipt is acknowledged of the amendment filed on March 3, 2003. In the amendment,
claim 20 was amended, and the Applicant indicated that new claims 23-44 were added. The
Examiner notes that in the original application filed, claims 1-24 were presented. Accordingly,
newly added claims in the latest amendment would be re-numbered to **25-46**. Currently, claims
15 20-22 and 25-46 remain for examination.

Obviousness-Type Double Patenting

20 The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

25 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 5 3. Claims 20, 25-28, 31-35, and 38-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of US Patent 6,477,134 to Stebbings et al. (hereinafter "Stebbings").

Above mentioned claims in instant application are directed at methods and system for authenticating a data in the data storage media in order to prevent unauthorized copying and use
10 of the storage media. Authentication is achieved by initially impregnating tracing substance within the media, and when the media is subsequently read, the substance is to be detected as an assurance of authenticity. The tracing substance includes at least one of silicate, a lead dioxide, tin, cadmium 12 and iridium 5 or combination thereof as recited in claims 25, 31, and 38. The detection of such elements are performed using the methodology including at least one of mass
15 spectrometry, neutron absorption and neutron spectrometry techniques.

It is the Examiner's view that such method and apparatus is identically disclosed in Stebbings. In claims 1-5 of Stebbings, a method for marking data disc product embedded with tracing purposes in order to inhibit at least one of piracy, unauthorized access and unauthorized copying of the data stored on the data disc product. Although Stebbings did not explicitly claim
20 a system for such authentication process, it is almost impossible without physical infrastructure to perform the claimed method. Accordingly, to one of ordinary skill in the art, the methods claimed inherently suggest that there exist a platform to conduct such methods.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application.

Allowable Subject Matter

5 4. Claims 42-46 are allowed.

5. Claims 21, 22, 29, 30, 36, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter:

10 claims are directed at methods and system for authenticating a data in the data storage media in order to prevent unauthorized copying and use of the storage. However, previously cited references, taken alone or in combination, fail to suggest or teach that authenticating steps includes at least two different security markings, each of which must be successively authenticated before accessing data. Applicant further claims that the authentication can be

15 performed over a plurality of interconnected computer networks comprising at least of local network, global network and Internet.

Conclusion

20 Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Ahshik Kim* whose telephone number is (703)305-5203. The examiner can normally be reached between the hours of 6:00AM to 3:00PM Monday thru Friday.

25 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (703) 305-3503. The fax number directly to the Examiner is (703) 746-4782. The fax phone number for this Group is (703)308-7722, (703)308-7724, or (703)308-7382.

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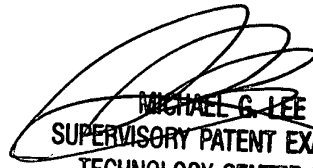
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ahshik.kim@uspto.gov].

5 *All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

10 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

15 Ahshik Kim
Patent Examiner
Art Unit 2876
May 14, 2003

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MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800